

**I. Claim Rejections under 35 U.S.C. § 103**

Claims 1-51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McGraw-Hill Primis Custom Publishing ([www.mhhe.com/primis](http://www.mhhe.com/primis)), archived circa 1998, via the Wayback Machine ([www.archive.org](http://www.archive.org)) (hereinafter “McGraw-Hill”).

The Examiner asserts that “storing of the first plurality of content entities in a data repository” is inherent in the McGraw-Hill reference to ensure that a user’s customized entities are stored in memory for immediate or later retrieval. However, although the customized entities of McGraw-Hill must be stored in some kind of memory, there is no teaching or suggestion that the first plurality of content entities (the customized book according to the Examiner) is stored in the data repository, namely, the Primis database, as asserted in the Office Action.

It is respectfully submitted that the McGraw-Hill reference does not necessarily store a customized book in the Primis database, nor does it even suggest as much. It appears, from McGraw-Hill reference, that if a customized book was stored in the Primis database, then that customized book would become available for selection in a customized book. This is because the Primis database is a “custom publishing database that contains a collection of modular, stand-alone text files that can be mixed and matched and then seamlessly arranged to create a book ‘on demand’ for a particular course.” See McGraw-Hill page 3.

In response to Applicant’s argument that McGraw-Hill does not disclose that a customized book (the first object according to the Office Action) is defined by a first list of content entity identifies and that there is no illustration in the McGraw-Hill reference as to what elements define a customized book, the Examiner refers to the Review hyperlink. The Review hyperlink permits a user to see what items have been selected so far. See McGraw-Hill page 9,

top of page. However, as previously submitted, there is no illustration in the McGraw-Hill reference as to what elements define a customized book. The Examiner refers to the "Microsoft Powerpoint Presentation on how to use Primis Online" (see page 4 of the Final Office Action), as evidence of how the "Review" feature displays information. However, it is respectfully submitted that that reference does not indicate a date of publication. In fact, it references events that occurred in 2000 (see page 2). The present application was filed very early in 2000 (January 21, 2000), and it is respectfully submitted that it is unlikely that the "Microsoft Powerpoint presentation" qualifies as prior art.

For at least the above reasons, claims 1, 6, 16, 21, 31 and 36 and their dependent claims should be deemed allowable.

## **II. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.116  
Appln. No.: 09/489,576

Attorney Docket No.: A8525

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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Respectfully submitted,



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